

REMARKS

Claims 1-3, 5, 8-16, 18, and 21-38 each stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Giovannoli (U.S. Patent No. 5,758,328) in view of Shkedy (U.S. Patent No. 6,260,024). Applicants respectfully traverse this rejection and request withdrawal thereof for at least the reasons set forth below. Applicants respectfully submit that no prima facie case of obviousness has been established. As the Examiner is aware, a prima facie case of obviousness requires the following: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP at 2143. Applicants submit that one or more of these criteria have not been met.

With regard to the first criterion, Shkedy and Giovannoli fail to provide any motivation to modify the references individually to try to arrive at the invention recited in each of the present claims. Additionally, there is no motivation in the references to combine them with one another. The Examiner has not shown any indication in Giovannoli that it is analogous prior art to buying and selling telecommunication services. In fact, Giovannoli and Shkedy teach away from one another. For example, Shkedy causes the seller after placing a bid on a pooled purchase order “PPO” to enter into a “legally binding contract” with an intermediary. (See Shkedy col. 6, lines 27-28). Giovannoli, on the other hand, discloses buyer requests for quotations from sellers. (See Giovannoli, col. 2, lines 35-37). In Giovannoli the seller is not capable of entering into a

“legally binding contract” because his response to the buyer’s request is merely a quote which the buyer may accept or reject. The two procedures are entirely different with different motivations by both buyer and seller under the two scenarios. It would therefore be improper to combine the references. See MPEP at 2145 X.D.2. (It is improper to combine references where the references teach away from their combination). Moreover, it appears that only using improper hindsight would one seek motivation to combine the references.

The state of the telecommunication industry at the time the present application was filed also demonstrated the lack of motivation to combine Shkedy and Giovannoli. For example, thousands, perhaps millions, of Americans receive telephone solicitations offering various telephone services on a daily basis. Many of these calls are unwanted altogether, others are taken by consumers who then switch telephone services based on intimidation, “quick selling”, or cheap enticements such as limited rebates, free minutes, or small cash offers. An industry of telemarketers revolves around this process. Consumers have beckoned for change. (See the January 21, 2000, comments by Colorado Attorney General, Ken Salazar at <http://www.ago.state.co.us/PRESREL/presrl00/prsrl4.htm>). The U.S. government is bereft with ideas of how to solve the problems associated with telephone solicitations, except to work with and monitor the telephone companies. The present inventors recognized the problems and offered a novel, pro-active, and consumer oriented solution by way of the present application, which heretofore has not been presented to the public. Giovannoli does not even recognize the demand for telecommunication reform, much less offer solutions to these problems. Shkedy fails to recognize the importance of buyer requests generating seller offers. The motivation to

combine these two references simply did not exist. The gap was simply too large between the combined Giovannoli and Shkedy disclosures. The failure of the telecommunication industry to recognize the gap is evidenced by the continuing public and governmental outcry for services provided by the claimed invention.

Even if for some reason Shkedy and Giovannoli were combined, despite there being no motivation to do so, the Office Action does not establish that one would have been even further motivated, having no knowledge of the invention at issue, to make further modifications and to combine the references in a particular manner to try and arrive at the claimed invention. See *In re Kotzab*, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The Office Action alleges that it would have been obvious to one of ordinary skill in the art to combine Shkedy with Giovannoli merely because it would be desirable. See Page 4. Applicants' respectfully submit that such assumption does not meet the requirements of a prima facie case of obviousness as set forth above. In particular, such hindsight analysis does not establish a prima facie case, as motivation to modify must be found in the references themselves. The Examiner has provided no evidence as to why one skilled in the art would be motivated to attempt to translate the systems of Shkedy and Giovannoli into the present invention. A statement that the references relied upon allegedly teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (MPEP 2142.01). The question is not whether the combination of Shkedy and Giovannoli are capable of performing the claimed invention (which they are not), but rather if the reference themselves teach or suggest the claimed process. They do not.

Additionally, the second prong of the obviousness analysis requires that the references provide a reasonable expectation of success if the modification is in fact made, which Giovannoli and Shkedy do not provide. The reasonable expectation of success must be found in the prior art, not in the Applicants' disclosure. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991). There is no indication in Shkedy or Giovannoli that would lead one to conclude that there was a reasonable expectation of successfully translating Shkedy and Giovannoli into a process for buying and selling telecommunication services. It appears that impermissible hindsight is being used to ascertain an expectation of success. As discussed above, the references expressly teach away from one another in terms of their approach toward the initial engagement between buyer and seller in a buyer-driven process. Shkedy discloses binding offers from buyers. Giovannoli discloses buyer requests for quotations from sellers. Consequently, the Applicants assert that this prong of a *prima facie* obviousness case has also not been established.

For at least these reasons, Applicants respectfully submit that the present invention as recited by Claims 1-3, 5, 8-16, 18, and 21-38 are allowable over the cited references of Shkedy and Giovannoli. As Claims 4, 6-7, 17, and 19-20 depend from such claims, Applicants submit that such claims are also allowable. Reconsideration and withdrawal of this rejection are respectfully requested.

Additionally, Claims 4 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli and further in view of Harper (U.S. Patent No. 5,416,833). However, as discussed above, the Examiner has not presented a *prima facie* case of obviousness as there is no suggestion in Harper, Shkedy, or Giovannoli to combine the three references in the

unique manner recited by Claims 4 and 17. As discussed above, merely stating that the combination would be desirable is not by itself a suggestion to combine, but instead is suggestive of using improper hindsight to combine references. Additionally, Claims 4 and 17 recite “obtain[ing] business demographics from the buyer.” Harper’s teaching of “demographics and life-style clues obtained during the contact” does not teach “obtain[ing] business demographics from the buyer” during registration of a buyer within the context of a method as described by Claim 1 or a system as described by Claims 14 and 15. Such context results in advantages unique to the claimed invention. Within such a context, such information can be used directly in selecting a pool of sellers or by such pool of sellers in determining a response to a buyer. For example, one embodiment of such recited inventions could allow a seller to make an offer to a buyer by comparing the recited business demographics to capabilities of the seller, desirable markets of the seller, or other items of interest within such demographics. The provision, collection, transmittal, and review of such information together an offer or other response as a result of such information may all take place within a single system. Harper’s mere teaching of the desirability of marketing surveys and other customer contacts do not teach or suggest the unique method and system recited by Claims 4 and 17 respectively, either alone or in combination with Shkedy and Giovannoli. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Additionally Claims 6 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli and further in view of Official Notice. However, as discussed above, the Examiner has not presented a prima facie case of obviousness as there is no

suggestion in Shkedy or Giovannoli to modify either of Shkedy or Giovannoli in view of Official Notice in the manner recited by Claims 6 and 19.

Additionally, the Examiner asserts that Giovannoli teaches identifying services and a shipping address. The Examiner further asserts Official Notice that people commonly identify install locations so that installed goods can be serviced. However, identifying products to order, stating a shipping address, and giving install locations to enable repairs in no way teaches or suggests “receiving an identification of business sites to receive the at least one telecommunication service,” “identifying telecommunication services for each of the business sites,” and “identifying desired features of each of the telecommunication services” as recited by Claim 1 and as analogous to Claim 14. The Examiner seems to be asserting that Giovannoli’s teaching of selecting products suggests both “identifying telecommunication services for each of the business sites” and “identifying desired features of each of the telecommunication services.” Clearly, selection of products does not suggest both limitations. Even if one ignores the context of the recited elements within the method and system recited by Claims 1 and 14, the recited manner of identifying desired features of telecommunication services *for each site* is in no way taught or suggested by merely identifying products, ship to locations, and giving an address so that maintenance can be performed. A buyer specifying a desired service for business sites A and B, and desirable features of each such business site A and B that may differ between sites A and B, is in no way taught or suggested by the references cited by or Official Notice taken by the Examiner. Without taking into account the further elements recited by Claims 1 and 14, the claimed invention allows a buyer the advantage of specifying different features for a particular

service for different sites to enable a group of sellers to receive a complete picture of the optimal implementation of multi-features services across a landscape of different business sites. When placed within an end-to-end process or network within the context of the unique method and system recited by Claims 1 and 14, the advantages of the claimed invention become even more apparent. Within such a context, such information can be used directly in selecting a pool of sellers or by such pool of sellers in determining a response to a buyer. For example, one embodiment of such recited inventions could allow a seller to make an offer to a buyer by comparing the desired features for each business site to capabilities of the seller and desirable markets of the seller. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Additionally Claims 7 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli and further in view of Official Notice. However, as discussed above, the Examiner has not presented a prima facie case of obviousness as there is no suggestion in Shkedy or Giovannoli to modify either of Shkedy or Giovannoli in view of Official Notice in the manner recited by Claims 7 and 20.

Additionally, the Examiner asserts Official Notice that car salesmen and telemarketers ask questions regarding your car trade in and present services respectively. Trade-in information is used to judge an appropriate offer for such trade in, not within the context of a purchasing process or system for a new car. Telemarketers ask questions to gather general feedback for companies on a particular market. In any event, telemarketing is a seller initiated process, not a buyer initiated on. Thus, obtaining information regarding the prior use of telecommunication

services within the context of a process or system as recited by Claim 1 and Claim 14 respectively is not taught or suggested by either of the cited references or the Official Notice. By including information regarding prior use in the request, telecommunication service providers can determine how good of an offer to make to a customer based in part on the information regarding prior use. For example, information regarding prior use may include the types of services used, the volume of services used, the times when services are used, etc. Thus, a customer may become more attractive because the information regarding prior use by the customer makes them a more attractive customer. When placed within an end-to-end process or network within the context of the unique method and system recited by Claims 1 and 14, the advantages of the claimed invention become even more apparent as the prior use information is directly available for review at any step in the process and by anyone having access to the process or system. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Applicants submit that the claimed invention is not rendered obvious by any of the cited references alone or in combination. Applicants respectfully submit that the present invention is in condition for allowance and allowance is respectfully requested. If the Examiner has any questions regarding this submission or if an interview at this time would further the progress of this application to a favorable conclusion, please contact the undersigned at the telephone number provided.

Thus, all grounds of rejection and/or objection are traversed or accommodated, and favorable reconsideration and allowance are respectfully requested. Should the Examiner have

any further questions or comments facilitating allowance, the Examiner is invited to contact Applicant's representative indicated below to further prosecution of this application to allowance and issuance.

Respectfully submitted,

PATTON BOGGS, LLP



Dated: October 28, 2003

Darren W. Collins
Registration No. 44,625

2001 Ross Avenue, Suite 3000
Dallas, Texas 75201
(Direct) (214) 758-6612
(Fax) (214) 758-1550